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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,191

06/25/2004

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Q82273

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23373 7590 12/24/2008
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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,191	Applicant(s) SANO, MASAHIRO	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-9, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, reference is made to “joined portions” “joining” adjacent protruding and/or decorative portions. It however is not clear exactly what the scope of a “joined portion” is. In other words, it is first not clear if this is a point/line or an area of some width. If it has some significant width, the boundaries thereof are not readily ascertainable. The scope of this term is critical to understanding the scope of the claims and potential applicability of the prior art. The claims (esp. claims 2, 3 and 8 as amended) seem to define the joined portions as essentially single points/lines between the adjacent protruding/decorative portions, i.e. not inclusive of adjacent portions such as flat or high decorative portions. The specification and for example claim 7 however refer to “bottoms” (19) of the joined portions. If the joined portions have bottoms, then they presumably can have parts at other heights from the sidewall - in other words, as used in the specification, it seems that the joined portions define more than simply the points/line “19” (i.e. also inclusive of at least some area on one or both sides thereof). Note also the brief description of fig. 6 which defines the joined portion as composed of essentially serrations and the brief description of fig. 7 which describes the joined portions as being made as flat portions. Clarification is necessarily of the scope of this term and the seeming contradiction of at least some of the present claims with the specification in this regard in order to be able to accurately and fully assess potential applicability of the prior art.

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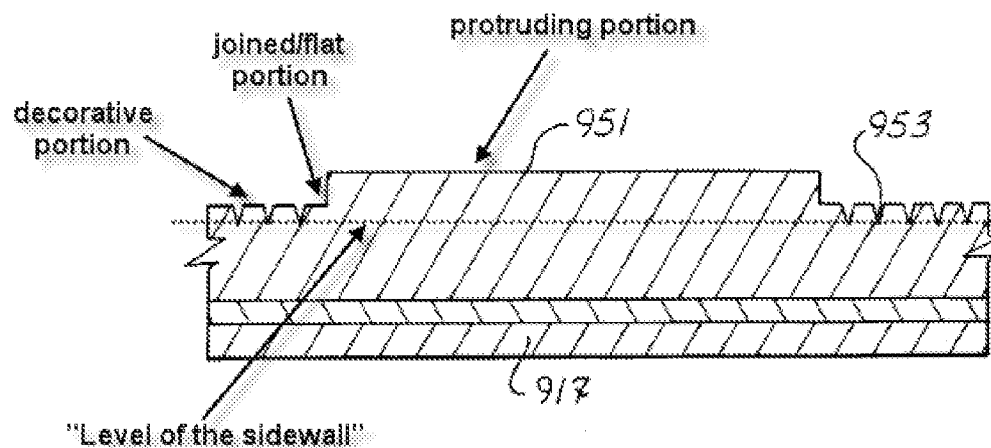
In claim 7, no antecedent has been established for "the bottom of the joined portion". Also, in claim 7/2, it is not clear which joined portion is being referenced.

In claims 2 and 8 as amended, reference is made to a "high decorative portion" between protruding portions but it is not clear what defining characteristic makes it a "high" decorative portion.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 3, 8, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp et al. (US 6,253,815).

Kemp et al. discloses a tire having a sidewall pattern that includes a decorative serrated portion (953), protruding portions (951) and a joined portion that joins the protruding portion to the decorative portion, this joined portion being higher than the bottoms of the serrations - note the following marked up copy of fig. 2:



(PRIOR ART)
Fig. 2

A tire as required by claim 1 is therefore anticipated by this disclosure. As to claims 2 and 8, since the "high decorative portion" is not distinguished from other parts of the decorative portion (e.g. it could be termed high if it is further radially outward on the sidewall), this reference also includes a serrated high decorative portion between protruding portions (e.g. between letters) and second joined portion.

As to claim 3, because of the angled orientation of the serrations (953 - fig. 1) and their flat tops, they define flat/joined portions that extend between protruding portions (i.e. between letters).

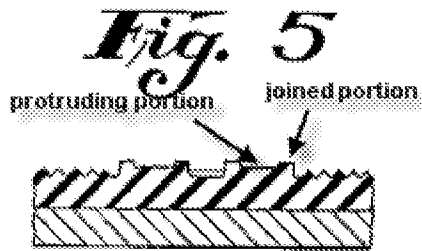
As to claims 9/11/13, Kemp et al. shows groups of letters.

4. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kemp et al. (US 6,253,815).

As to claim 7, the illustrated relative dimensions are considered to suggest or certainly render obvious relative heights within the broadly claimed range following the guidance provided by this figure.

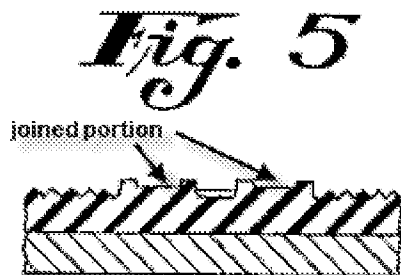
5. Claims 1, 2, 3, 8, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by D204585 to Vizina.

Vizina discloses a tire including serrated decorative portion superimposed with protruding marks (esp. figs. 2 and 5). Further, higher joined portions that join the protruding portions to the decorative portion and thus read on the claim 1 requirements are provided as indicated in the below annotated fig. 5.



Claim 1 is therefore anticipated by this disclosure. As to claims 2 and 8, again, since the "high decorative portion" is not distinguished from other parts of the decorative portion (e.g. it could be termed high if it is further radially outward on the sidewall), this reference also include a serrated high decorative portion between protruding portions (e.g. between the letters "L") and second joined portion.

As to claim 3, Vizina can be interpreted with the flat portions between raised protruding portions as the claimed flat/joined portions as below:



In such case, there can also be defined joined portions between the protruding portions and the decorative portion as the serrations have surfaces higher than the bottoms of the serrations which *intersect* and thereby join with the protruding portions and thereby

define higher joined portions where they engage the protruding portions. The claim requires nothing more than this.

As to claims 9/11/13, Vizina shows groups of letters (i.e. letter "L").

6. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over D204585 to Vizina.

As to claim 4, the parts between adjacent protruding parts are flat and can be said to suggest or render obvious the claim 4 relative dimensions reading the dimension of the protruding ends as being from for example the outer ends thereof.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over D204585 to Vizina or Kemp et al. (US 6,253,815) as applied above, and further in view of JP 2000-255224 (cited by applicant) and optionally Ratliff, Jr. (US 5,807,446) as applied in the last office action.

8. Applicant's arguments filed 9/16/2008 have been fully considered but they are not persuasive.

The arguments are mostly moot in view of the new grounds of rejection/new interpretations necessitated by the amendments to the claims. The rejection over Baker has been withdrawn as being at present less relevant against the claims as amended. Vizina and newly reapplied Kemp et al. are applicable against the claims as amended for the reasons detailed in the statement of rejection above.

This rejection has not been made final as the 35 USC 112 rejection was not clearly necessitated by the amendments to the claims.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
December 22, 2008